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REMARKS/ARGUMENTS

Claims 1-22 are rejected. Claims 1-22 remain pending.

102 Rejections:

Claims 1-5 are rejected as anticipated by Novak, Jr, US 5,343,543. This rejection is respectfully traversed for the following reasons.

First, the Examiner's only comment regarding the rejection of the five claims is that:

"Claims 1-5 are rejected under 35 USC 102(b) as being clearly anticipated by Novak, Jr. et al. See figure 1 and column 5, line 27 to column 8, line 61."

It is respectfully urged that it is difficult for the Applicant to respond to such a rejection where the Examiner does not indicate where at least some of the claim elements are found in the reference cited by the Examiner. It is respectfully requested that the next office action be non-final and provide a more detailed explanation of the rejection in the event the Examiner does not allow the rejected claims.

Second, anticipation requires that a single prior art reference teach all the claim limitations. It is respectfully urged that the '543 patent does not teach or suggest at least one or more claim limitation set forth in Claims 1-5.

For instance, with respect to Claim 1, it is respectfully urged that Novak does not teach an optical fiber having a treatment region, a first depth indicating region, and second depth indicating region, where the primary depth indicating region originates with a first primary mark and terminates with a third primary mark. In particular, it is not seen how a first and third ones of the markings 36 of Novak Jr. et al provide a first depth indicating region.

Additionally, with respect to Claim 1, even if Novak Jr. were somehow construed to illustrate such a first depth indicating region, it is not seen how Novak Jr. et al. teaches a first depth

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indicating region which includes a secondary primary mark approximately 5mm from the first primary mark, as recited in Claim 1.

With respect to Claim 2, the Examiner has not shown how Novak Jr. teaches a main mark between a first primary mark and a second primary mark.

With respect to Claim 3, the Examiner has not shown how Novak Jr. teaches a first depth indicating region comprising a halfway point mark between the second primary mark and the third primary mark.

Similarly, with respect to Claims 4 and 5, the Examiner has not attempted to show how Novak Jr. teaches the recited arrangement of first and second midway marks.

Claims 14-18 and 22 are rejected as anticipated by Rowland et al. (US 5,427,115) by the Examiner. Again, it is respectfully urged that the rejection is improper because the Examiner has not set forth how each limitation/element of the rejected claims is taught by the alleged anticipatory reference.

Claim 14 recites, in part, the step of viewing at least two exposed markings on a surgical instrument, wherein the at least two exposed markings are markedly different markings, and wherein the plurality of markings are arranged such that any two markings will uniquely identify a location on the surgical instrument within a depth indicating region of the surgical instrument.

The Examiner is respectfully urged to explain how the subject matter of Claim 14 is anticipated by Rowland et al.

With respect to Claim 15, the Examiner does not explain how Rowland et al. anticipates the claim. In particular, it is respectfully urged that Rowland does not disclose the first primary mark, second primary mark, and a halfway point mark, wherein the halfway point mark is markedly different than the first and second primary marks.

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With respect to Claims 16 and 17, the Examiner does not appear to have addressed the claim elements set forth. For instance, it is respectfully urged that Rowland et al. does not teach or suggest a first midway mark and second midway mark, as recited in Claim 16, nor a halfway point mark that is markedly different than the first midway mark and the second midway mark, as recited in Claim 17.

With respect to Claim 22, it is respectfully urged that the Rowland et al. reference does not teach:

an elongated portion having a proximal end and a distal end positionable at a site of use, said elongated portion comprising a first depth indicating region; wherein said first depth indicating region originates with a first primary mark at its distal end, terminates with a second primary mark at its proximal end, and comprises a halfway point mark between said first primary mark and said second primary mark, wherein said first primary mark, said second primary mark, and said halfway point mark are around the entire circumference of said elongated portion, wherein said halfway point mark is markedly different than said first primary mark, and said halfway point mark is markedly different than second primary mark;

Accordingly, withdrawal of the rejections is requested.

103 Rejections:

Claims 6-13 and 19-21 are rejected as obvious over Novak Jr. et al. and Rowland et al. According to the Examiner, Novak Jr. et al. teaches a device such as claimed except the markedly different marks and circumferential marks, and Rowland et al. teaches a device as claimed except "putting the marks on an optical fiber per se and the use of discontinuous circumferential marks."

It is respectfully urged that this rejection is improper for the reasons set forth above regarding rejection of the base independent claims.

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Further, the Examiner is required to show motivation in the prior art for combining the two references. It is respectfully urged that one would not be motivated to combine the Rowland reference with the Novak Jr. reference, as suggested by the Examiner. For instance, the two references are classified in different USPTO classes on their face.

Further, the Examiner's proposed combination would use the circumferential markings of Rowland in the device of Novak, Jr, yet this would seem to be contrary to Novak's teaching of the desirability of using "linear" markings to delineate the direction of radiation to be emitted from a side firing laser. (See abstract of Novak Jr, and column 3, lines 15-21 of Novak, Jr.).

Accordingly, it is respectfully urged that there would be no motivation to combine the teachings of Rowland et al. with the teachings of Novak Jr. et al. Accordingly, the obvious rejection is improper and should be withdrawn.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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